PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Elect #9 4/29/03 BLOSS

In re the Application of

Hiroshi OKUBO et al.

Group Art Unit: 3713

Application No.: 09/555,630

Examiner: M. O'Neill

Filed: July 6, 2000

Docket No.: 106348

For: GAME MACHINE AND INFORMATION STORAGE MEDIUM

RESPONSE TO RESTRICTION REQUIREMENT

Director of the U.S. Patent and Trademark Office
Washington, D.C. 20231

Sir:

In reply to the Restriction Requirement mailed March 20, 2003, Applicants provisionally elect Group I, claims 1-12 and 25-36 drawn to the game machine for using an optical disk using the synchronization means thereon and a method of reading an optical disk to utilize synchronization means thereon. This election is made with traverse.

Applicants also traverse the requirement because the inventions of Groups I, II, III and IV are not subcombinations usable together, as alleged. Moreover, the invention of Group II (claims 13-18) is not what it is alleged to be. Claims 13-15 recite an optical disc, whereas claims 16-18 recite an information storage medium for reading data from an optical disk.

The invention of Group I is a combination with respect to what are characterized in the office Action as subcombinations, i.e., the inventions of Groups II and IV, whereas claims 13-15, allegedly part of the invention of Group II, do not recite a subcombination, nor does the invention of Group III, claims 19-21, which also recites a combination.

Claims 13-15 merely recite an optical disk, and Applicants respectfully submit that an optical disk is not a combination of any elements. Moreover, the subcombinations of Group II and IV do not appear to be usable together except to the extent that Group II includes claims 15-17.

Applicants respectfully submit that the new holding of lack of unity of invention is improper for at least these reasons, and should be withdrawn.

Furthermore, it is respectfully submitted that the subject matter of Groups I, II and III is sufficiently related that a thorough search for the subject matter of the elected Group (I) would encompass a search for the subject matter of the Groups II and III, especially because they are all classified in the same class, and allegedly in only three different subclasses. Thus, it is respectfully submitted that the search and examination of the invention of Groups I, II and III could be made without serious burden. See MPEP §803 in which is stated that "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (Emphasis added). It is respectfully submitted that this policy should apply in the present application to avoid unnecessary delay and expense to Applicants and duplicative examination by the U.S. Patent and Trademark Office.

In view of the foregoing, it is respectfully submitted that claims 1-36 can be examined without undue burden on the Examiner. Accordingly, it is respectfully requested that the Restriction Requirement be withdrawn.

Respectfully submitted,

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JAO:RJW/sxb

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